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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,332	04/23/2001	Jerald A. Hammann	H238.101.101	4071
25281 7590 12/27/2006 DICKE, BILLIG & CZAJA, P.L.L.C. FIFTH STREET TOWERS 100 SOUTH FIFTH STREET, SUITE 2250 MINNEAPOLIS, MN 55402			EXAMINER VAN DOREN, BETH	
			ART UNIT 3623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/27/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/840,332

Applicant(s)

HAMMANN, JERALD A.

Examiner

Beth Van Doren

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final office action in response to communications received 10/04/2006. Claims 31-35 have been amended. Claims 31-40 are pending in this application.

Response to Arguments

2. Applicant's arguments with respect to claims 1-25 and 61-85 have been considered but are moot in view of the new grounds of rejection, set forth below.
3. Examiner acknowledges applicant's remarks with regard to the provisional obviousness-type double patenting rejection.

Examiner Note

4. Examiner notes that on page 10, lines 4, of the remarks filed 10/04/2006, Applicant states that claim 31-35 remain pending. However, claims 31-40 remain pending in the current application.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 31, 32, 33, 34, 35, and 36-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 12, 17, 22, and 66-70 of copending Application No. 09/999,378. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only modifications between the claims are the timing of the communications and the intention of the communications. With regards to claim 31 of the current application, claim 31 recites "accepting, via computer, transaction parameter values" which is not recited in claim 1 of the copending application. Both claims recite in the preamble that the method is a computer-based method. Therefore, this "via computer" limitation of claim 31 is merely reciting aspects of the preamble in the body of the claim. Therefore, modifying the current application to include that the transaction parameters are accepted via a computer is respectfully considered obvious to one of ordinary skill in the art at the time of the invention. Further, claim 31 of the current application recites "wherein the at least one service date and service time is a date and/or time measure indicating a present or future first date and/or time when the service is available", whereas claim 1 of application 09/999,378 recites "wherein the service time is a present or future time when the service is available" and thus does not include the language "a date and/or time measure indicating". A date or a time is a measure or indication of quantity of time. For example, both May 5 and 9 AM-5 PM indicate an amount of time. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include that a date of time is a measure indicating a present or future first date and/or time in order to more accurately account for time intervals using known and standard units.

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Finally, Claim 31 of the current application recites "wherein the measure of an ability to produce and/or make available additional quantities [...] is related to at least one human factor resource and is not a static ability" which is not recited in claim 1 of the copending application. First, both claims recite "an ability to make available additional quantities", and thus the fact that the measure is not static is obvious in light of this language because the "ability to make available additional quantities" is a dynamic quality. Therefore, the modification of the current application to include that the ability to make available additional quantities is not static is respectfully considered obvious to one of ordinary skill in the art at the time of the invention. Second, the limitation of the current application "wherein the measure of an ability to produce and/or make available additional quantities [...] is related to at least one human factor resource" does not include any functional significance as to how or why the composite resource is related to at least one human factor resource. It is well known in the art that many composite resources are associated with a human factor, such as resources being related to human scheduling, calculation, and ability to manufacture, to name a few examples. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include an association between the composite resource and a human factor resource in order to more accurately measure the ability to make available the composite resource by considering all factors associated with this ability, such as human error.

Claims 32, 33, 34, and 35 of the current application and claims 7, 12, 17, and 22, respectively, of the copending application have the same, obvious modifications there between as claims 31 and 1. Therefore, although these conflicting claims are not identical, they are not patentably distinct from each other, as discussed above.

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Claims 36-40 of the current application and claims 66-70, respectively, of the copending application are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 31-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ghaisas et al. (U.S. 2002/0198756).

As per claim 31, Ghaisas et al. teaches a computer-based method for yield management, comprising:

accepting, via a computer, transaction parameter values for composite resources, wherein each composite resource has associated therewith at least a service location and at least one of a service date and a service time (See paragraphs 4, 7, 21-2, 29, 30, 33, 36-7, 41-2, 44-8, 52, wherein values associated with composite resources (multiple resources required to be combined to produce a product) are accepted and stored in the computer system. These resources have factory and supplier information associated with them (location) as well as timing information).

communicating at least a portion of the transaction parameter values for at least one composite resource to at least one potential user of the composite resource (See paragraphs 4, 21-2, 29, 41-2, 44, 52, 63-4, 97), the communication *attempting to modify* at least one of the demand for the at least one composite resource and the capacity of the at least one composite resource (See paragraphs 4, 21-2, 29, 41-2, 44, 52, 63-4, 97, wherein the system communicates to a user/customer, wherein at times there is excess capacity or excess demand and the communication attempts to modify the demand), wherein when the capacity exceeds demand for the at least one composite resources, the communication attempts to increase the demand for and/or decrease the capacity of the at least one composite resource (See paragraphs 4, 21-2, 29, 41-2, 44, 52, 63-4, 97, wherein the system communicates to a user/customer transaction values (based on availability), wherein at times there is excess capacity);

wherein the at least one service date and service time is a date and/or time measure indicating a present or future first date and/or time when the service is available (See paragraphs 4, 7, 21-2, 29, 30, 33, 36-7, 41-2, 44-8, 52, wherein timing information is associated including an availability or delivery date);

wherein the communication occurs prior to any first assignment of other concurrently-consumed and/or concurrently utilized composite resource to the at least one potential user (See paragraphs 4, 7, 22, 36, 39, 41-2, 44, 52, 63-4, wherein the communication of available capacity occurs prior to the delivery of other concurrently utilized resources).

Examiner notes that the fact the communication *attempts to modify* at least one of the demand for the at least one composite resource and the capacity of the at least one composite resource is regarded as intended use. A recitation directed to the manner in which a claim is

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intended to be used does not distinguish the claim from the prior art if the prior art has the capability to so perform. MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987). In this case, the act or step of communicating is not changed by what is intended to occur after the communication is delivered. Thus, "attempting to modify" is outside the scope of the positively recited steps. Thus, the following limitations are also outside the scope of the positively recited steps as they further limit the intended use:

wherein the capacity of the at least one composite resource is a measure of the on-hand supply and/or availability, if applicable, of the at least one composite resource at a first date and/or time plus a measure of an ability to produce and/or make available additional quantities of the at least one composite resource over a first date and/or time period beginning at the first date and/or time and ending at a second date and/or time;

wherein the measure of an ability to produce and/or make available additional quantities of the at least one composite resource over a first date and/or time period beginning at the first date and/or time and ending at a second date and/or time is related to at least one human factor resource and is not a static ability; and

wherein the demand for the at least one composite resource is a measure of the on-hand consumption and/or utilization, if applicable, of the at least one composite resource at the first date and/or time plus a measure of an ability to consume and/or utilize additional quantities of the at least one composite resource over the first date and/or time period.

The claim does not specifically recite that any actual modification occurs; rather, the claims merely recites that values are accepted and communicated. Thus, these limitations are an intended use of the claimed invention and do not result in a difference that patentably

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distinguishes the claimed invention from the prior art. If the prior art is capable of performing the intended use, then it meets the claim.

Claim 32 is substantially similar to claim 31 and is therefore rejected using the same art and rationale set forth above. Examiner notes that this claim is a system claim. Therefore, the intended use does not result in a structural difference that patentably distinguishes the claimed invention from the prior art. In this case, since the prior art structure is capable of performing the intended use, it meets the claim, based on the same rationale set forth above.

Claim 33 recites substantially similar elements to claim 31. Therefore, teaches claim 33, as set forth above in the rejection of claim 31. Ghaisas et al. further teaches a storage device storing a program and a processor connected to the storage device and controlled by the program, the processor operative with the program (See paragraphs 24, 28-33). Examiner notes that this claim is a system claim. Therefore, the intended use does not result in a structural difference that patentably distinguishes the claimed invention from the prior art. In this case, since the prior art structure is capable of performing the intended use, it meets the claim, based on the same rationale set forth above.

Claim 34 is rejected using the same art and rationale set forth above in the rejection of claim 31. Ghaisas et al. further teaches storing the data related to the individual resources and the associated composite resources (See paragraphs 22, 24, 28-33, 57, wherein individual resources are used to complete products made of composite resources);

constructing internal data structures which link each of the individual resources to associated composite resources and link each of the composite resources to associated individual

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resources (See paragraphs 22-4, 28-33, 37, 39, 40-1, 57, wherein resources are stored as linked to the products they produce).

Claim 35 recites substantially similar elements to claim 31. Therefore, teaches claim 33, as set forth above in the rejection of claim 31. Ghaisas et al. further teaches receiving a responding communication from at least one user binding the at least one composite resource with specified transaction parameter values (See paragraphs 22-4, 28-33, 37, 39, 40-1, 57).

As per claims 36-38 and 40, Examiner notes that the fact the communication attempts to modify at least one of the demand for the at least one composite resource and the capacity of the at least one composite resource is regarded as intended use. A recitation directed to the manner in which a claim is intended to be used does not distinguish the claim from the prior art if the prior art has the capability to so perform. MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987). In this case, the act or step of communicating is not changed by what is intended to occur after the communication is delivered. Thus, "attempting to modify" is outside the scope of the positively recited steps. Thus, the following limitations are also outside the scope of the positively recited steps as they further limit the intended use:

wherein, when demand exceeds capacity for the at least one composite resource, the communication attempts to decrease the demand for the at least one composite resource and/or increase the capacity of the at least one composite resource.

The claim does not specifically recite that any actual modification occurs; rather, the claims merely recites that values are accepted and communicated. Thus, these limitations are an intended use of the claimed invention and do not result in a difference that patentably

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distinguishes the claimed invention from the prior art. If the prior art is capable of performing the intended use, then it meets the claim.

As per claim 39, Ghaisas et al. discloses indicating, when the demand for a composite resource exceeds the capacity of the composite resource, that the demand for the composite resource should be decreased and/or the capacity of the composite resource should be increased (See abstract, paragraphs 4, 7, 36, 41-2, 50-2, 66, wherein when the demand exceeds capacity, capacity is rebalanced and demand shifted).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bvd

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December 18, 2006

Beth Van Doren
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AU 3623